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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,405	12/15/2003	William Sobonya	MAEE 2 00034	6233
27885	7590	06/29/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/736,405

Applicant(s)

SOBONYA, WILLIAM

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/3/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 15 is objected to because of the following informalities: the first word of line 2 should be "the". Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6911406 (Application 09/891568). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.
4. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/736404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6, 7, 9, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hamilton et al. (US 2005/0112314). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed.

Hamilton et al. (US 2005/0112314) disclose a high bond strength, repositionable adherent sheet. The sheet material can be used in shelves [0034]. The sheet material can be embossed [0030 & 0072] on the front surface [0003]. It would have been obvious to one having ordinary skill in the art to have used Hamilton's embossing steps on the laminate of Hawley et al., motivated by the desire to create a laminate having a pattern or design on the surface.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hamilton et al. (US 2005/0112314) as applied to claim 1 above, and further in view of Owen (US 5,874,371). Hawley et al. and Hamilton et al. disclose the claimed invention except for the teaching that the scrim comprises a non-woven scrim.

Owen (US 5,874,371) discloses a non-skid covering for use on a surface (abstract). The scrim comprises a PVC coated non-woven scrim (claims 5 and 6). It would have been obvious to have used Owen's coated non-woven scrim as the scrim in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate having cheaper processing costs.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) and Hamilton et al. (US 2005/0112314) as applied to claim 1 above, and further in view of Aliabadi (US 2003/0036323). Hawley et al. and Hamilton et al. disclose the claimed invention except for the teaching that the scrim is a polyester.

Aliabadi (US 2003/0036323) disclose a shelf liner comprising a top layer of a smooth polyvinyl chloride covering a sandwich layer of a polyester fabric between layers of polyvinyl chloride (abstract). A layer of polyester mesh fabric is between layers of polyvinyl chloride [0023]. It would have been obvious to have used the polyester mesh of Aliabadi in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate having the effects and properties associated with polyester.

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley et al. (US 6,130,174) in view of Hamilton et al. (US 2005/0112314) and Schottenfeld (US 2002/0094404). Hawley et al. disclose a laminate having nonslip characteristics. The laminate comprises a smooth film and a scrim (abstract). The scrim is woven plastic scrim (col 2, ln 56-58) coated by a polyvinyl chloride plastic (claim 1). A vinyl plastic film (col 3, ln 4-10) is laminated to the scrim via an adhesive (col 4, ln 40-42). The vinyl film has a thickness of .004-.008 inches, 4-8 mils (col 2, ln 5-7). Hawley et al. disclose the claimed invention except for the teaching that the laminate is embossed and that there is a protective removable covering on the laminate.

Hamilton et al. (US 2005/0112314) disclose a high bond strength, repositionable adherent sheet. The sheet material can be used in shelves [0034]. The sheet material can be embossed [0030 & 0072] on the front surface [0003]. Schottenfeld (US 2002/0094404) discloses a liner for covering a generally smooth surface comprising a PVC sheet [0019] and a PVC coated scrim [0020]. A release layer is added to the liner [0024]. It would have been obvious to one having ordinary skill in the art to have used Hamilton's embossing steps on the laminate of Hawley et al., motivated by the desire to create a laminate having a pattern or design on the surface. It would have been obvious to have used the release layer of Schottenfeld in the laminate of Hawley et al. and Hamilton et al., motivated by the desire to create a laminate that has improved handling characteristics.

It also would have been obvious to one having ordinary skill in the art to have made the textured finish to have a leather or linen-like appearance, motivated by the desire to create a laminate that blends in with its surroundings.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *ucn*

*ula Ruddock*  
**Ula C. Ruddock**  
Primary Examiner  
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